

following comments. Claim 1 has been rewritten as new claim 38 to remove the functional language.

In the subject application the Examiner has not allowed a claim, indicating that claims 1, 5-11, and 30-31 have been rejected under 35 U.S.C. 112 on the basis of non-enablement. The Examiner has stated that there are no examples in the specification showing data for lowering cholesterol triglycerides and only one example for the synthesis of the ester was found. The Examiner concludes that one skilled in the art would have to perform undue experimentation to practice the claimed invention. As the Examiner has noted, Applicant's claims are directed to a nutritional supplement comprising a sterol ester of an omega three fatty acid.

Applicant notes the disclosure on page 4, line 15, page 6, line 25 provide sufficient disclosure of a broad scope of sterols and omega -3 fatty acids contemplated to be within the scope of the subject claims. As stated in *In re Marzocchi and Horton*, 169 USPQ 367 (CCPA 1971), "a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirements of the first paragraph of 112, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." Further, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." Applicant

Serial No. 09/385,834

has provided in this disclosure the necessary teaching commensurate in scope to the claims. Working examples are not necessary, as intimated by the Examiner. Applicant's specification contains a teaching of the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented.

The Examiner has provided no explanation of why other sterols could not be used in the process disclosed to synthesize the claimed invention, even when this deficiency was pointed out. As a result, there is no basis in the record to conclude that one skilled in the art would not be able to prepare sterol esters of an omega fatty acid along the general outline of the example in the disclosure.

Applicant hereby requests reconsideration and reexamination thereof.

With the above amendments and remarks, this application is considered ready for allowance. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to call the undersigned at the below-listed number.

Respectfully submitted,

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